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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,619	10/29/2003	Robert W. Miller	27336-2	5578
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BENESCH, FRIEDLANDER, COPLAN & ARONOFF LLP ATTN: IP DEPARTMENT DOCKET CLERK 2300 BP TOWER 200 PUBLIC SQUARE CLEVELAND, OH 44114			QIN, YIXING	
			ART UNIT	PAPER NUMBER
			2622	

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/696,619	MILLER ET AL.	
	Examiner	Art Unit	
	Yixing Qin	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 10/29/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1 2, 3, 4, 5, 7, 10, 14, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watkins et al (U.S. Patent No. 5,459,819).

Regarding claim 1, Watkins et al discloses an image input device in Fig. 1. In Fig 3 and column 7, lines 42-45, Watkins et al describes the usage by saying that "...the customer may provide one or more photographs which will be scanned by input device 14 which produces a digital signal which is supplied to the CPU 10" The photograph ("physical image") is being digitized after being read by an input device.

Further regarding claim 1, Watkins et al discloses in column 8, lines 13-25, that "...the customer generated image may be modified to look like a water colored painting, a poster, line sketch, or otherwise..." Furthermore, Watkins et al discloses that "this is done in accordance with the capabilities of the computer software at the appropriate time..." The software contains the "image processing logic" that is being claimed, and the size of a photograph is enlarged.

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Further regarding claim 1, Watkins et al discloses in column 6, lines 26-48, a variety of output devices each individually configured to print different formats. Watkins et al also mentions "...various other devices may be provided for transferring onto various other formats such as...garments, mugs, posters..."The point is that a "large format print mechanism" or the like is needed to print to large objects such as garments and posters. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include use a "large format print mechanism." The motivation is to be able to print onto large mediums.

Regarding claim 2, in addition to disclosing the information in claim 1, Watkins et al discloses in column 8, lines 28-30, that "...for examples, if the output is to be a 11X14 color print produced by output devices 32..."

Regarding claim 3, in addition to disclosing the information in claim 2, Watkins et al discloses all of the information claimed in claim 2, and further discloses in column 2, lines 9-10, that output devices can be items "...such as a thermal printer, CRT printer, ink jet printer..."

Regarding claim 4, in addition to disclosing the information in claim 1, Watkins et al discloses in column 8, lines 13-25, that "...the customer generated image may be modified to look like a water colored painting, a poster, line sketch, or otherwise..." Furthermore, Watkins et al discloses in column 6, lines 26-48, a variety of output devices each individually configured to print different formats. Watkins et al also

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mention "...various other devices may be provided for transferring onto various other formats such as...garments, mugs, posters..."

Regarding claim 5, in addition to disclosing the information in claim 1, Watkins et al discloses in column 2, lines 6-9, that input devices can be items "...such as film scanner, print scanner..."

Regarding claim 7, in addition to disclosing the information in claim 1, Watkins et al discloses in column 8, lines 17-21, that various attributes of the image can be manipulated, such as the "...sizing and cropping of the image, changing the color of a item in the image such as hair or eye color, fixing of imperfections in the original image such as streaks, lines, spots or red eye..."

Regarding claim 10, in addition to disclosing the information in claim 1, Watkins et al discloses in column 7, lines 10-19, that "...a customer and/operator will visually examine...a plurality of prestored images provided in the memory of the CPU...The user will select one of the prestored images which will be combined with one or more consumer-generated images that are provided."

Regarding claim 14, in addition to disclosing the information in claim 12, Watkins et al discloses in column 6, lines 26-48, a variety of output devices each individually configured to print different formats. Watkins et al also mentions "...various other devices may be provided for transferring onto various other formats such

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as...garments, mugs, posters..." The point is that a "large format printer" or the like is needed to print to large objects such as garments and posters. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include use a "large format print mechanism." The motivation is to be able to print onto large mediums.

Regarding claim 15, in addition to disclosing the information in claim 12, Watkins et al discloses in column 3, lines 1-3, saying that "providing said first generated images by scanning and existing image..."

Regarding claim 16, in addition to disclosing the information in claim 12, Watkins et al discloses in column 6, lines 17-19, that an "...input device, comprises a CD (compact disc) reader for reading digitally stored information on a compact disc. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use any "computer-readable medium." The motivation is to be able to carry a large number of images for printing.

2. Claims 6, 8, 9, 12 , and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watkins et al (U.S. Patent No. 5,459,819), and further in view of Perine et al (U.S. Patent No. 5,832,193).

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Regarding claim 6, the Watkins et al reference discloses all of the limitations except for a "network logic" that allows communication with a "remote imaging device for imaging." The secondary reference, Perine et al, discloses in column 4, lines 16-23, that "...image input section 4 has a network 5 with a suitable communication channel such as an EtherNet.RTM. connection enabling image data in the form of image signals or pixels from one or more remote sources to be input to system 2 for processing." Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include a remote image transmission means. The motivation is to be able to print images from other locations.

Regarding claim 8, Watkins et al discloses all of the limitations except for the inclusion of "...an interface configured to communication information between a user and allow the user to select imaging properties..." The secondary reference, Perine et al, discloses in column 5, lines 39-46, an UI (user interface) and how it "...interfaces with the operator with printing system 2, enabling the operation to program print jobs and other instructions, and to obtain system operation information, visual document facsimile display, programming information and icons, diagnostic information and pictorial views, etc." Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include an interface where a user can choose to "...select imaging properties to be applied to the digital image." The motivation is to allow users to be able to customize their pictures before printing.

Regarding claim 9, Watkins et al discloses all of the limitations except for the inclusion of "...a laser printer." The secondary reference, Perine et al, discloses in column 4, line 55, a "...laser type printer..."

Regarding claim 12, Watkins et al discloses an image input device in Fig. 1. In Fig 3 and column 7, lines 42-47, Watkins et al describes the usage by saying that "...the customer may provide one or more photographs which will be scanned by input device 14 which produces a digital signal which is supplied to the CPU 10. Box 104 illustrates the capturing of the image as is accomplished by the input device 14." The photograph ("physical image") is being digitized after being read by an input device.

Further regarding claim 12, Watkins et al discloses in column 8, lines 13-25, that "...the customer generated image may be modified to look like a water colored painting, a poster, line sketch, or otherwise..." Furthermore, Watkins et al discloses that "this is done in accordance with the capabilities of the computer software at the appropriate time..." The software contains the ability to convert the image into a "...selected large format size."

Further regarding claim 12, the Watkins et al reference fails to explicitly teach the concept of on-demand printing. However, the secondary reference Perine et al, teaches in column 1, lines 28-36 that "Electronic printing systems of the type...are particularly well suited for "print-on-demand" applications..." and "(t)his print-on-demand

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functionality makes electronic printing systems particularly well suited for print shop applications..." Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use on demand printing by applying the on demand printing that Perine et al discloses to Watkins et al's invention. The motivation is to enable the customer/operator to have images printed quickly.

Regarding claim 13, in addition to disclosing the information in claim 12, the Watkins et al reference fails to explicitly teach the concept of scaling. However, the secondary reference Perine et al, teaches in column 4, lines 49-51, that "...enhancements and changes to the image signals such as filtering, thresholding, screening, cropping, scaling (reduction/enlargement), etc. "

3. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watkins et al (U.S. Patent No. 5,459,819), and further in view of Rosenlund et al (U.S. Patent No. 6,738,155).

Regarding claim 11, Watkins et al discloses all of the limitations except for the inclusion of "...a search engine configured to search the database." The secondary reference, Rosenlund et al, discloses in column 6, lines 48-54, a "DCM system 130 is utilized to perform content management operations as described herein and in particular with reference to FIG. 11...Content management operations, such as, search, select, place, and save provide for the page design and platemaking of printing and publishing system 100." Furthermore, in column 8, lines 21-23, Rosenlund et al

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discloses that the "DCM system 130 includes a database server device 132 and a database 134." Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have a search operation that acts on a database. The motivation is to be able to quickly find images that the user is looking for.

4. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watkins et al (U.S. Patent No. 5,459,819) in view of Perine et al (U.S. Patent No. 5,832,193), and further in view of Rosenlund et al (U.S. Patent No. 6,738,155).

Regarding claim 17, the Watkins et al and Perine et al references disclose all of the limitations except for the inclusion of "...a remote content database." The tertiary reference, Rosenlund et al, discloses in column 8, lines 21-23, that the "DCM system 130 includes a database server device 132 and a database 134. The DCM is a part of the central service facility as seen in Fig 1 of Rosenlund et al, and described in column 2, lines 51-64. In particular, Rosenlund et al discloses in column 2, lines 62-64 that "(t)he central service facility provides storage, file processing, remote access, and content management operations."

Regarding claim 18, the references Watkins et al and Perine et al disclose all of the limitations of claim 18, with the exception of the ability to search a database. The tertiary reference, Rosenlund et al, discloses in column 6, lines 48-54, a "DCM system 130 is utilized to perform content management operations as described herein and in

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particular with reference to FIG. 11...Content management operations, such as, search, select, place, and save provide for the page design and platemaking of printing and publishing system 100. ” Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have a search operation that acts on a database. The motivation is to be able to quickly find images that the user is looking for.

5. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watkins et al (U.S. Patent No. 5,459,819) in view of Perine et al (U.S. Patent No. 5,832,193), and further in view of Liebenow (U.S. Patent No. 6,480,673)

Regarding claim 19, the Watkins et al and Perine et al references teaches all the limitations of claim 19, but fails to disclose information regarding payment. The tertiary reference, Liebenow, discloses in column 4, lines 41-50, that “...the customer may swipe a credit card or debit card through the payment acceptor...” which transfers information to the “...information handling system 102, which determines whether adequate payment has been received for the kiosk 100 to begin printing the photographic data.” Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use payment for on demand printing by applying the payment method disclosed by Liebenow to the on demand printing method that Perine et al adds to Watkins et al’s invention. The motivation is to enable the

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customer/operator to have images printed quickly and for the business creating the images to make money.

6. Claims 20, 21, 22, 23, 27, 28, 29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg (U.S. Patent No. 6,526,158).

Regarding claim 20, Goldberg discloses in column 6, lines 48-53, that "the camera 63, (captures) and image of the car 45 and its passenger patron 43. The digital image so captured by camera 63 is then transmitted to the storage controller 73 through an image transfer wire 65, from which it is then stored in image storage device 71." The camera that Goldberg talks about is a digital camera and can be used to capture images. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to include an image input device. The motivation is to enable the reception of image(s) for processing and printing

Further regarding claim 20, Goldberg discloses in fig. 2, and column 6, lines 54-67, and column 7, lines 1-6, that a there is a kiosk that "...incorporates a monitor 85 on which captured images are displayed for the patron 43 to review." Furthermore, "(i)teraction means are provided to the patron 43, to select and choose images by presentation of the images on a viewing screen 85." Furthermore, the kiosk in Goldberg's reference has buttons label "YES" and "NO" to answer questions. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention

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to include an "user interface configured to receive selected options..." The motivation is to enable the user to customize his or her printing experience.

Further regarding claim 20, Goldberg discloses in column 15, lines 56-59, that "manipulating the image to produce special photographic effects such as adjusting contrast or color, cropping, enlarging, etc." is possible. Although Goldberg does not explicitly disclose that there is an option on the kiosk to do so, he does disclose in column 7, lines 1-23, a couple of example questions that might be ask to the customer. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to include have an option on the kiosk that asks the customer whether he/she wants to enlarge the image. The motivation is to enable the user to customize his or her printing experience.

Further regarding claim 20, discloses in column 15, lines 16-20, that "(t)he storage controller 73 will then place the images and information on the storage device 71 within a database structure that allows for easy search and retrieval of the image and data." Furthermore, Goldberg discloses in column 15, lines 66-67 and column 16, lines 1-4, that there is a "...combination if those extracted images with appropriate background images in an image combination step 243, possibly in conjunction with some modification of the patron images..." These images could be stored in a database, and the customer's image could be enlarged as mentioned about. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention

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to include a database with images to combined together. The motivation is to enable the user to customize his or her printing experience.

Further regarding claim 20, Goldberg discloses in column 16, lines 11-15 that "...the distribution station 77, could include means for accepting money from the client, using one or both of a cash payment slot or credit payment slot..."

Further regarding claim 20, Goldberg discloses in column 16, lines 39-41 that "...within each distribution station 77 is a printer 137 for the production of printed image for delivery to a patron..." Although Goldberg does not explicitly disclose that the printer is of a "large format" or that the printing is on-demand, it would have been obvious to one of ordinary skill in the art at the time of the invention to print the image when payment was received. Furthermore, it would have been obvious to simply use a bigger print mechanism depending on the type of image being printed. The motivation is to be able to let the customer get prints of his or her images quickly.

Further regarding claim 20, Goldberg discloses in column 25, lines 17-19 that "...the image data 195 may be transferred to a fabric printer 201 for placement on a fabric substrate such as a T-shirt 215 or a cap." Although Goldberg does not explicitly disclose that the printer is of a "large format" or that the printing is on-demand, it would have been obvious to one of ordinary skill in the art at the time of the invention to print the image when payment was received. Furthermore, it would have been obvious to

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simply use a bigger print mechanism depending on the type of image being printed.

The motivation is to be able to let the customer get prints of his or her images quickly

Regarding claim 21, Goldberg discloses in column 16, lines 55-59 that “ the suitability of a particular printer may be determined by the characteristics of the printing output specified, such as ...ceramic mugs, metallic films, fabrics, or posters...”

Although Goldberg does not explicitly disclose an “image forming device means,” the various printers must have one form or another of a image processing means to form the different types of outputs. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include some “image forming device means.”

Regarding claim 22, Goldberg discloses in column 16, lines 55-59 that prints can be made on ” ...ceramic mugs, metallic films, fabrics, or posters...” Although Goldberg does not explicitly say that the printing is larger than 8 X 11, it is obvious to one of ordinary skill in the art that a poster is a relatively large format, and would be larger than 8 X 11. The motivation is to be able to let the customer get larger prints to display.

Regarding claim 23, Goldberg discloses in column 16, lines 55-59 that prints can be made on ” ...ceramic mugs, metallic films, fabrics, or posters...” Although Goldberg does not explicitly say that the printing is larger than 11 X 17, it is obvious to one of ordinary skill in the art that a poster is a relatively large format, and would be larger than 11 X 17. The motivation is to be able to let the customer get larger prints to display.

Regarding claim 27, Goldberg discloses in column 15, lines 56-59, that the patron can perform actions such as "...manipulating the image to produce special photographic effects such as adjusting contrast or color, cropping, enlarging, etc..."

Regarding claim 28, Goldberg discloses in column 15, lines 16-19, that the "...storage controller 73 will then place the images and information on the storage device 71 within a database structure that allows for easy search and retrieval of the image."

Regarding claim 29, Goldberg discloses in column 15, lines 53-59, that "(at) the distribution station 77," patron can perform actions such as "...manipulating the image to produce special photographic effects such as adjusting contrast or color, cropping, enlarging, etc..."

Regarding claim 31, Goldberg discloses in fig 2. and column 6, lines 50-54, that the "...(t)he digital image captured by the digital camera is then transmitted to the storage controller 73 through an image transfer wire 65, from which it is then stored in image storage device 71." Goldberg also discloses in fig. 2 and column 6, lines 59-61 that "images are to be retrieved from the image storage device 71 through distribution cable 81." Furthermore, Goldberg discloses that there is a database structure in the storage device (see claim 28 rejection above). Therefore it would have been obvious to

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one of ordinary skill in the art at the time of invention to have a remotely accessible database. The motivation is to be able to access images from different places.

7. Claim 24, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg (U.S. Patent No. 6,526,158) and further in view of Nardozzi et al (U.S. Patent No. 6,636,837).

Regarding claim 24, the Goldberg reference discloses all of the limitations of claim 24 except for a "...monitoring logic to track usage of the kiosk..." However, the secondary reference Nardozzi et al discloses in column 10, lines 44-46, that his invention "...provides a method to record every consumer order as it is placed through the kiosk."

Regarding claim 25, the Goldberg reference fails to disclose the "...monitoring logic to track usage of the kiosk..." from claim 24, and the usage of the data from in statistics from claim 25. As mentioned above, the secondary reference Nardozzi et al discloses the use of a method of recording consumer data. Furthermore, the secondary reference Nardozzi et al discloses in column 10, lines 55-57, that his invention "...during the day at various times...the computer 39 at the photofinishing lab can poll all of the computers 14 to determine what orders have been placed that day. " Furthermore, Nardozzi et al discloses in column 11, lines 16-18, that the "...computer 39 also

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maintains a record of what is being sold..." so that "...consumer purchases and trends can be monitored in detail."

Regarding claim 26, the Goldberg reference fails to disclose the "...monitoring logic to track usage of the kiosk..." from claim 24, and the tracking of a particular image in claim 26. As mentioned above, the secondary reference Nardozzi et al discloses the use of a method of recording consumer data. Furthermore, Nardozzi et al reference discloses in column 10, lines 27-30, that his "...invention allows for easy repositioning of the offerings and by tracking and analyzing the sales of the various offerings, it can determine the best position for any particular offering." Also Nardozzi does not explicitly state that the "offering" is an image, it is obvious to one of ordinary skill in the art at the time of invention to use an image as an "offering." The motivation is to be able to generate better sales based on the tastes of people.

8. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg (U.S. Patent No, 6,526,158) in view of Rosenlund et al (U.S. Patent No. 6,738,155).

Regarding claim 30, the Goldberg reference discloses all of the limitations of claim 30 but does not explicitly disclose the type mechanism in which the printer uses. However, the secondary reference Rosenlund et al discloses in column 9, lines 41-43, the concepts of "...inkjet plotting..." and "...black and white laser printing..." Although Rosenlund et al does not explicitly disclose that this is a "large format printer" that

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contains these mechanisms, it would have been obvious to one of ordinary skill in the art at the time of the invention to simply apply these techniques to a large format printer. The motivation is to be able to print different types of large format prints more efficiently.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yixing Qin whose telephone number is 703-306-4142. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 703-305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YQ


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